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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/376,461	08/18/99	RILLIE D	1128.006A

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EXAMINER	
COHEN, C	
ART UNIT	**PAPER NUMBER**
3634	4

DATE MAILED: 10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/376,461	Rillie
Examiner	**Group Art Unit**
Curtis Cohen	3634

☒ Responsive to communication(s) filed on *Jul 31, 2000* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-15* is/are pending in the application.

Of the above, claim(s) *10-15* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-9* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 2, the recitation of "at least one rib" is indefinite because it is not clear if this is a duplicate recitation of the rib recited in claim 3 or is this a different rib?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Chao et al #5,896,713. Chao et al teach a skylight having a flashing that is a frustoconical shaped curb. A

skirt extends from the curb and includes a plurality of surface strengthening ribs that extend radially on the skirt.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBlock et al #5,655,339 in view of Hoy et al and Strieter. DeBlock et al teach that it is known in the art to provide a tubular skylight comprising a flashing, a transparent dome, a skylight tube, and a frustoconical shaped curb defining an open top. DeBlock et al do not teach a seamless flashing. Hoy et al teach that it is known in the art to provide a seamless curb member 45 as recited in claim 6 of Hoy et al to provide a leak-proof and condensation-proof assembly. For this reason, it would have been obvious to make DeBlock et al as a seamless structure as taught by Hoy et al. DeBlock et al further do not teach a "metal flashing." Strieter teaches that it is known in the art to use a metal in construction of a roof flashing since metal provides superior durability and can be formed into the particular shape of a specific application. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicant's invention, to provide DeBlock et al with a metal flashing as taught by Strieter.

Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBlock et al. Hoy et al and Strieter as applied to claim 1 above, and further in view of Blackmon et al #5,956,191. DeBlock et al, Hoy et al and Strieter teach the invention as discussed in the rejection above including the teaching of a skirt. Neither reference teaches that it is known to provide a plurality of ribs oriented radially on the skirt. Blackmon et al teaches that it is known to provide a plurality of ribs 40 extending outwardly to fortify the plate member. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide DeBlock et al with a radially extending reinforcing member as taught by Blackmon et al.

Response to Arguments

Applicant's arguments filed July 31, 2000 have been fully considered but they are not persuasive.

Applicant argues on page 3 of the amendment that the Examiner's rejections have been overcome by indicating that the flashing is "metal." As applicant is aware, the Chao et al constructed from a metal material. Therefore, with respect to the Section 102(e), this is a moot point. With respect to the Section 103 rejection, although it is believed that DeBlock et al teach a metal flashing, DeBlock et al are not clear from what material the flashing is made. Therefore, a new rejection has been applied.

Applicant argues with respect to the Section 112 rejection of claim 5 that the "at least one peripheral rib", as recited in lines 2-3, can be the same rib or a different rib. This language remains indefinite because the claim cannot include a duplicate recitation of the rib of claim 3.

That is, claim 3, line 2 recites "plural ribs" which are supported by the specification. However, there is not support for a separate "at least one rib." If the "at least one rib" refers to one of the "plural ribs", then the claim should recite --wherein said plural ribs includes at least one peripheral rib-- in claim 5.

Applicant argues that Hoy et al cannot be formed of a metal flashing because a metal cannot be vacuum formed unlike plastic. Applicant appears to be relying on the process of forming the metal flashing as the point of novelty of the instant invention. It is the examiner's position that the process of stamping a seamless metal member is a well-known expedient in the art. Furthermore, the process of forming the flashing is given little patentable weight because it is the product which defines the invention, not the process by which it is made.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Particularly, the inclusion of "metal"in the independent claims required a new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

October 8, 2000

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600